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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,640	11/25/2003	Kenneth G. Miller	F-711	5612

7590 12/08/2006
Ronald Reichman
Pitney Bowes Inc.
Intellectual Property and Technology Law Dept.
35 Waterview Drive, P.O. Box 3000
Shelton, CT 06484

EXAMINER

HAMILTON, LALITA M

ART UNIT PAPER NUMBER

3691

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,640

Applicant(s)

MILLER ET AL.

Examiner

Lalita M. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Summary

On September 6, 2006, the Applicant filed an Appeal Brief. Prosecution has been reopened. A new action follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Pintsov (5,586,036).

Pintosov discloses a method for payment with mailer and carrier data comprising giving one or more bills in the form of one or more mail pieces to a bill recipient, placing a code by a creditor on one or more bills that references the bill recipient, the bill recipient's account number and amount due on the face of the mail piece, mailing the bill by the bill recipient, scanning by the post the code on the mail piece before the mail piece is delivered to the creditor, creating an electronic funds transaction for the amount indicated in the code between the bill recipient's bank account and the creditor's bank account, and transferring funds from the bill recipient's bank account to the creditor's bank account (col.8, lines 25-40; col.9, line 43 to col.10, line 31; and col.11, lines 14-30—carrier is the creditor and mailer is the bill recipient); a first code that references the bill recipient's account number and amount due and a second code that references the

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location of the bill recipient (col.8, lines 25-40; col.9, line 43 to col.10, line 31; and col.11, lines 14-30); the first code is a Planet code and the second code is a Postnet bar code (col.8, lines 25-40; col.9, line 43 to col.10, line 31; and col.11, lines 14-30--codes contain all information necessary information); indicating on the mail piece after funds have been transferred to the creditor's bank account from the bill recipient's bank account that the bill has been paid (col.8, lines 25-40; col.9, line 43 to col.10, line 31; and col.11, lines 14-30); delivering the mail piece indicting that the bill has been paid to the bill recipient (col.8, lines 25-40; col.9, line 43 to col.10, line 31; and col.11, lines 14-30); the first code references a record in a data base that references the bill recipient's bank account, amount due, the account being paid, and the second code represents the physical location of the bill recipient (col.8, lines 25-40; col.9, line 43 to col.10, line 31; and col.11, lines 14-30); the first code indicates that an electronic funds transaction will take place (col.8, lines 25-40; col.9, line 43 to col.10, line 31; and col.11, lines 14-30); code placed by the creditor indicates the minimum amount that is due (col.8, lines 25-40; col.9, line 43 to col.10, line 31; and col.11, lines 14-30); the code placed by the creditor indicates the entire amount that is due (col.8, lines 25-40; col.9, line 43 to col.10, line 31; and col.11, lines 14-30); code placed by the creditor indicates an amount greater than the minimum amount that is due is going to be paid (col.8, lines 25-40; col.9, line 43 to col.10, line 31; and col.11, lines 14-30); placing an indication on the bill by the bill recipient that indicates the amount greater than the minimum amount that is due is going to be paid (col.8, lines 25-40; col.9, line 43 to col.10, line 31; and col.11, lines 14-30); and delivering a billing mail piece from a creditor to a bill recipient, the

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billing mail piece including a bill and a bill-paying return mail piece, receiving the bill-paying return mail piece mailed by the bill recipient, the bill-paying return mail piece having a code printed thereon that identifies at least one of the bill recipient and the bill an amount due on the face of the mail piece, recipient's account number and scanning the code on the bill-paying return mail piece before the mailpiece is delivered to the creditor, and initiating an electronic funds transaction for the amount indicated in the code from the bill recipient's bank account to the creditor's bank account (col.8, lines 25-40; col.9, line 43 to col.10, line 31; and col.11, lines 14-30).

Response to Arguments

Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kalinowski Alexander can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

In view of the appeal brief filed on September 9, 2006, PROSECUTION IS
HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

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(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Alexander Kalinowski, SPE

A handwritten signature in black ink, appearing to read 'Alexander Kalinowski', written over a horizontal line.A handwritten signature in black ink, appearing to read 'Lalita M. Hamilton', written over a horizontal line.

Lalita M. Hamilton
Primary Examiner, 3691